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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389 7590 07/11/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PHAN, HUY Q				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

HUY Q. PHAN

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-29, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on date: 04/28/2008.
Claims 28-29, 32 and 33 are still pending.

Response to Arguments

2. Applicant's arguments with respect to the amended limitation of claims 30, 31 and 37 have been fully considered but they are not persuasive.

I) Applicant argued that

Lynch fails to teach or suggest a "...means for receiving a message that includes a first list of a plurality of network identifiers that are available for a potential handover from the mobile communication network with which the user equipment is connected..." recited in Claims 29, 32 and 33 and similarly recited in claim 28"; or more specifically stated "That is, the unit of Lynch does not receive the plurality of SIDs from the wireless system (communication network) to which it is connected".

The examiner respectfully disagrees with the applicant's argument. Lynch discloses that "it is necessary to establish a wireless bidirectional communication path between the subscriber unit and a remote control center. The subscriber unit is activated when it is to receive the updated preferred SID list" see col. 12, line 65-col. 13, line 2). Since, the subscriber unit of Lynch could receive a preferred SID list (read on the claimed limitation "a first list") wirelessly and directly from the remote control center (read on claimed limitation "the mobile communication network"); therefore, Lynch discloses the claimed limitations "*means for receiving a message that includes a first list of a*

plurality of network identifiers that are available for a potential handover from the mobile communication network with which the user equipment is connected...

II) Applicant also argued that "the preferred SID list of Lynch is not a list of networks available for hand-off". The examiner respectfully disagrees with the applicant's argument. Lynch discloses that the preferred SID list is contained a plurality of network identifiers ("a list of SIDs for preferred system providers" see 8, lines 45-50), which are made available for the subscriber unit ("Such system providers usually have a special contractual relationship with the home service provider of the roaming subscriber so that the subscriber receives preferential treatment" see col. 8, lines 45-50). Since these available network identifiers are stored and used for a potential handover case ("compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5); therefore, Lynch discloses the claimed limitation "a first list of a plurality of network identifier that are available for a potential handover".

III) In response to applicant's arguments against the references individually as stated in the REMARKS as "Daly and Gandhi fails to teach or suggests the "means for receiving a message that includes a first list of a plurality of network identifiers that are available for a potential handover, from the communication network with which the user equipment is connected" recited in Claims 29, 32 and 33 and similarly in Claim 28", one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (see the explanation the sections above and

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the rejection below). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618) in view of Daly (US-6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available (see col. 8, lines 45-50) for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5) with which the user equipment is connected (see col. 12, line 65- col. 13, line 2); and

comparing ("compared", col. 12, lines 1-8) the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-8) and is stored in the user equipment ("stored"; col. 12, lines 1-8).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-8) of a plurality of network identifiers that are available (see col. 8, lines 45-50) for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5) which the user equipment is connected (see col. 12, line 65-col. 13, line 2); and

means for comparing ("compared", col. 12, lines 1-8) the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-8) and is stored in the user equipment ("stored"; col. 12, lines 1-8).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 33, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

a receiver (fig. 1, 12) for receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available (see col. 8, lines 45-50) for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5) with which the user equipment is connected (see col. 12, line 65-col. 13, line 2); and

a comparator (fig. 1, 12) for comparing ("compared", col. 12, lines 1-8) the received first list with a second list ("received SIDs"; col. 12, lines 1-8) which includes at least one network identifier and is stored in the user equipment ("stored"; col. 12, lines 1-8).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,586,338) in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280; previously cited).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message (col. 8, lines 1-4) that includes a first list ("stored preferred SID list"; col. 12, lines 1-8) of a plurality of network identifiers that are available (see col. 8, lines 45-50) for a potential handover ("hand-off", col. 12, lines 1-8), from the communication network (fig. 1, 10 and fig. 5) which the user equipment is connected (see col. 12, line 65-col. 13, line 2);

means for comparing ("compared", col. 12, lines 1-8) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-8) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-8) and is internally stored in the user equipment ("stored"; col. 12, lines 1-8); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (col. 10, lines 55-60 and/or col. 11, lines 38-59).

But, Lynch does not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying to the user equipment neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information";

see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

Conclusion

4. **THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/
Examiner, Art Unit 2617
Date : 07/08/2008

/George Eng/
Supervisory Patent Examiner, Art Unit 2617